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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,956	02/19/2002	Shuichi Hirayama	SN-US025009	3435
22919	7590	07/18/2006	EXAMINER	
GLOBAL IP COUNSELORS, LLP 1233 20TH STREET, NW, SUITE 700 WASHINGTON, DC 20036-2680			STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 07/18/2006

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/076,956  
Filing Date: February 19, 2002  
Appellant(s): HIRAYAMA, SHUICHI

**MAILED  
JUL 18 2006  
GROUP 3700**

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David J. McCrosky  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed April 24, 2006 appealing from the Office action mailed January 10, 2006. Although Appellant listed "In re application of: Shinpei OKAJIMA", it is noted that the above noted appellant HIRAYAMA, SHUICHI is the only listed inventor in the above identified application on appeal.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,012,236	POZZOBON	1-2000
3,925,916	GARBUIO	12-1975
5,746,015	CLEMENT et al.	05-1998
5,775,006	BREUNER	07-1998

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 6-7, 9-13, 17-21, 23 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pozzobon 6,012,236 in view of Garbuio 3,925,916 and Clement et al. 5,746,015. Pozzobon '236 discloses a boot liner 2 with a sole portion (see Figure 1, sole portion is that portion located under the upper portion in the figure); the boot liner 2 having an upper portion (see Figure 1) having a foot section fixedly coupled to the sole portion (see Figure 1); an ankle section extending upwardly from the foot section (also see Figure 1, boot upper is tall enough to cover the ankle); a leg section extending upwardly from the ankle section (see Figure 1, that portion of the upper above the ankle); the upper portion including a thermoformable layer 3, 103 located on an inner side and an outer side of the ankle section (inner side of ankle section is the side of the user's foot that faces the other foot, i.e. medial side of the foot; outer side of the ankle section is that side of the boot that faces what is usually called the lateral side of the foot); the thermoformable layer extends along the foot section (see Figures 1 and 2, thermoformable layer 3, 103 is shown in Figure 1 and Figure 2 shows it extending along the foot); the thermoformable layer 3, 103 extends along the leg section (see Figure 2); the sole portion being made of the thermoformable material (same as the upper as it is the closed bottom portion of the upper). Pozzobon '236 does not teach the banana-shaped pads located near the ankles and the limitations associated with the banana-shaped pads. Garbuio '916 discloses a first banana-shaped pad (8) located in the outer side of the ankle section; a second banana-shaped pad (8) located in the inner side of the ankle section; the banana-

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shaped pads made of different material (polyurethane) than the upper (made of polyethylene) and formed of polyurethane; the upper portion includes a foam layer disposed on an interiorly facing side of the thermoformable layer (A, the inner boot layer or medial side of the boot); the upper portion includes an outer layer disposed on an exteriorly facing side of said thermoformable layer (A, the lateral side of the boot); the sole portion is a separate member that is coupled to the foot section of the upper portion (see Figure 1); the sole portion is constructed of a flexible material (see col. 2, lines 8-15); the sole portion includes an outer sole section that is fixedly coupled to said foot section of the upper (see Figure 1, sole outer sole attached to the upper); the outer sole section of the sole portion includes an exterior layer of PVC material; the outer sole section of the sole portion further includes an interior thermoformable layer; the banana-shaped pads have a maximum vertical height and a maximum horizontal width that is approximately equal to the maximum vertical height (see Figure 1). Garbuio '916 teaches that it is desirable to have these pads located on the inner boot to allow for a better and more snug fit of the boot to the user's foot. Therefore, it would have been obvious, to one of the ordinary skill in the art at the time the invention was made, to place banana-like pads, such as that taught by Garbuio '916, on the liner of Pozzobon '236, to aid in better fitting the liner to the user's foot to better translate the forces applied to the sole of the boot. With respect to the thickness of the first and second banana-shaped pads being thicker than the thermoformable layer, Garbuio '916 teaches that the pair of elastic pads 8 could be made of the same material as that of the core 4. As shown in Figure 4, the core material 4 is thicker than the thermoformable layer 3 and therefore, the pads 8 of Garbuio '916 would be thicker than the thermoformable layer, as taught by Garbuio '916. The references as applied immediately above disclose all the limitations of the claim except for the upper portion including an inner layer disposed on an interiorly facing side of the thermoformable layer with the first and second banana-shaped pads located between the thermoformable layer and the inner layer. Clement et al. '015 teaches that the upper portion of a liner can have an inner layer 12 disposed on an interiorly facing side of an outer upper layer 11 with

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padding 5 located there between. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place an inner layer inside the thermoformable layer with the banana-like pads located there between to provide for better and proper cushioning of the boot on the user's foot.

3. Claims 8, 15, 16, 22, 24-25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied above in view of Breuner 5,775,006. The references as applied above disclose all the limitations of the claims except for the tightening device fixed to the upper with a first strap portion overlying a part of the first banana-shaped pad and a second strap portion overlying a part of second banana-shaped pad and the tongue and inner sole. Breuner '006 teaches that an inner sole section 46 can overlie the outer sole portion 14 to aid in gaining user comfort. Breuner '006 further teaches that a boot liner can have a tongue 48 attached thereto to close the slit in the boot to prevent ingress of unwanted material into the boot. Furthermore, Breuner '006 teaches that a strap portion can overlie a boot insert and aid in attaching the outer boot to the inner boot, thereby closing the inner boot and aiding in the prevention of ingress of unwanted material with the tongue. Therefore, it would have been obvious, to place a tongue on the inner boot upper as well as straps to attach the outer boot to the inner boot and prevent the ingress of material into the boot.

#### **(10) Response to Argument**

For ease of reference, the examiner's response to Appellant's arguments will be labeled with the same lettering/numbering as that used by the Appellant in the Appeal Brief.

A. **Response to arguments that the rejection under 35 U.S.C. §103(a) over the Pozzobon patent in view of the Garbuio patent and the Clement et al. patent.**

Appellant argues that the inner boot 1 of Pozzobon would not be modified with the pad 8 of Garbuio because Pozzobon does not disclose a boot. Clearly, in Figure 1 of Pozzobon, a boot is disclosed and shown. Furthermore, appellant argues that one would not take the features of the boot 1 of Garbuio and apply them to the inner boot 1 of Pozzobon. Since both Pozzobon and Garbuio include an inner boot (1 in Pozzobon and 2 of Garbuio), the teachings of what Garbuio does with his inner boot would be relevant to that of Pozzobon. Appellant argues that the pad 8 of Garbuio is intended to work in conjunction with the air-impervious area A of the liner and therefore any use of the pad 8 would require the use of an air-impervious area used in conjunction with the pad. Garbuio clearly teaches, in column 2, lines 28-38, that the pad 8 is used in the region of the ankles to add additional protection because the material of the pads 8 is denser than the core portion 4a. Therefore, any lateral pressure acting upon pad 8 will be distributed by the resilient core 4a over the area A for effective cushioning of the foot without materially impeding its mobility. Therefore, the pad 8 used in Garbuio is used to cushion impact and help translate the force to a greater area located underneath. There appears to be no requirement in Garbuio that the pad 8 needs to be used with an air-impervious material to provide the protection and cushioning disclosed. With respect to appellant's arguments that the use of the pad 8 and insert 2 of Garbuio on the boot of Pozzobon would render the inner boot unsatisfactory for its intended purpose. This argument is not completely understood as the examiner did not propose using the inner boot 2 of Garbuio with the boot 1 of Pozzobon, only that Garbuio teaches the use of pads 8 located at the ankle portions of an inner boot to aid in cushioning and protection. With respect to appellant's arguments that Pozzobon uses vapor-permeable material and not air-impervious material, the type of material used for the boot, whether it be vapor-permeable or air-impervious, does not affect the use of the pads 8 in the ankle area for protection and cushioning as this would occur no matter what material was used behind the pads. Therefore, appellant's contention that an air-impervious area A would be required of the inner boot 1 of Pozzobon finds no support in the teachings of the use of pads 8. The placing of a pad, such as that

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referred to by reference number 8 in Garbuio, on the inner boot of Pozzobon would not limit the flow of air throughout the boot as this pad would take up a small area and still allow air flow throughout the rest of the boot, thereby still achieving the ventilation required by Pozzobon while benefiting from the cushioning and protecting of the user's ankles because of the placement of pad 8. With respect to appellant's arguments directed to the combination of Clement et al. with Pozzobon, appellant argues that one would not be motivated to provide a wedging element made of thermoplastic foam, as taught by Clement et al., in the boot of Pozzobon because Pozzobon's boot is already made of thermoformable material and has a wedging element 5 already located within the boot. Clement et al. was used to teach the location of a thermoformable cushioning layer 5 between the inner and outer layers of the boot and therefore teaches the location of such a layer within Pozzobon for the same reasons as stated in the rejections set forth above. Appellant further argues that Garbuio teaches the use of the pads to interact with the exteriorly facing air-impervious A of the liner 2 for effective cushioning and therefore using the pads 8 between the interior and exterior walls like the wedging element 5 of Clement et al. would be contrary to the teachings of Garbuio. Since the pads 8 would be placed between the walls of Pozzobon and still provide cushioning and protection of the user's ankle, the use of the pads 8 of Garbuio in the boot of Pozzobon would not destroy the function and purpose of pads 8 as described in Garbuio, for cushioning and protection of the user's ankle.

**B. Response to arguments that the rejection under 35 U.S.C. §103(a) over Pozzobon in view of Garbuio and Clement et al and further in view of Breuner.**

4. Since it is noted in Section A above that Pozzobon in view of Garbuio and Clement et al. is not deficient with respect to the claims they are applied to, the Breuner patent need not make up for any of those proposed deficiencies. Breuner was used to teach that an inner sole section 46 can overly the



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outer sole portion 14 to aid in gaining user comfort. Breuner '006 further teaches that a boot liner can have a tongue 48 attached thereto to close the slit in the boot to prevent ingress of unwanted material into the boot. Furthermore, Breuner '006 teaches that a strap portion can overly a boot insert and aid in attaching the outer boot to the inner boot, thereby closing the inner boot and aiding in the prevention of ingress of unwanted material with the tongue. Therefore, it would have been obvious, to place a tongue on the inner boot upper as well as straps to attach the outer boot to the inner boot and prevent the ingress of material into the boot. Appellant argues that the thickness of pads 8 in Garbuio has not been discussed or illustrated. This limitation was discussed in the rejection set forth in the Final Office action and above in paragraph 2 of the rejections section. The thickness of the banana-shaped pads was equated with the showing in Figure 5 of Garbuio that the area 4a, which pad 8 is made of the same material, is thicker than portion 3, which is a thermoformable material (resin is thermoformable). With respect to appellant's arguments that the examiner uses layer 3 from Garbuio and Pozzobon to show the thermoformable layer, this combination, as proffered by the appellant, was not made by the examiner. The examiner, in the rejections set forth under (9) Grounds of Rejection above has not used both layers of Pozzobon and layer 3 of Garbuio for the same claimed element. Layers 3 and 4a of Garbuio were used to show the relationship of a thermoformable layer 3 and a cushion layer 4a and how that would translate to where pad 8, made of the same material as 4a, would be located in the boot of Pozzobon. The examiner did not propose placing layer 3 of Garbuio in the boot of Pozzobon as inferred. Appellant further argues that none of the references show an upper portion including first and second banana-shaped pads located in an upper portion. The pads of Garbuio are located "in" the outer side of the liner when referring to the side of the liner that is to the outer side of the user's foot, and therefore would meet the limitations as presented in the claims. It appears appellant is equating the word "in" with the phrase "as part of" when referring to the outer side to inner side of the ankle section. Therefore, any pad located adjacent to the outer side or inner side would meet the claim limitation that the "banana-shaped pad be located in said

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inner side of said ankle section". Appellant further argues that Breuner does not teach strap portions fixed to an upper portion of the boot liner. Breuner clearly shows in Figure 1, 3, and 5 that when the straps are tightened, the straps are "fixed" to the liner. The straps are attached to the boot 12, but remain "fixed" to the inner boot upper when fastened.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

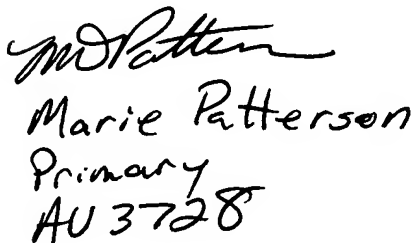


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